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**REMARKS**

This Request is submitted in response to the Office Action mailed on January 27, 2006. Claims 1 - 8 and 15 - 31 are pending, and all stand rejected at present. Claim 16 and its dependent claims 24, 30, and 31 have been cancelled.

**RESPONSE TO OBVIOUSNESS REJECTIONS**

All claims were rejected as obvious, based on Suer.

**CLAIM 1**

**Point 1**

Claim 1 recites:

1. A method comprising: **identifying an ATM** which has a screen for displaying options for withdrawing cash and a touch input mechanism for receiving user commands; and modifying said ATM to enable it to receive from a wireless telephone user commands for dispensing cash.

This "identifying" process has not been identified in Suer. The Office Action, pages 4 and 5, lists characteristics supposedly found in Suer. However, at no location does the Office Action point out the claimed "identifying" in Suer.

MPEP § 2143.03 states:

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To establish prima facie obviousness . . . **all** the **claim limitations** must be taught or suggested by the prior art.

**Point 2**

Claim 1 recites a "modifying" operation:

. . . modifying said ATM to enable it to receive from a wireless telephone user commands for dispensing cash.

The Office Action purports to find a wireless device in Suer, which issues commands to an ATM, and then states:

[Suer discloses] modifying the ATM to enable it to receive from a wireless device user commands for dispensing cash.

(Office Action, page 4, bottom.)

However, several problems exist in this statement.

Problem 1

If Suer **modifies** an ATM, then an **unmodified** ATM must be present, or discussed by Suer. No **unmodified** ATM is found in Suer. Thus, Suer does not discuss modification of an ATM.

Problem 2

The Office Action is plainly relying on the doctrine of Inherency, in asserting that Suer shows the claimed modifying

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process. MPEP § 2112 states:

EXAMINER MUST PROVIDE RATIONALE OR EVIDENCE TENDING TO SHOW INHERENCY.

In relying upon the theory of inherency, the examiner must provide a **basis in fact and/or technical reasoning** to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teaching of the applied prior art.

The Office Action presents no "basis in fact" or "technical reasoning." Instead, it

- 1) sets forth a characterization of Suer and then
- 2) issues the naked conclusion that Suer shows a certain type of modifying process.

(Office Action, page 4.)

A naked conclusion does not qualify as the required "basis in fact" or "technical reasoning."

### Point 3

The claim states that the ATM is modified to allow "it to receive from a wireless telephone user commands for dispensing cash."

The Office Action makes two statements in asserting that Suer shows the claimed "wireless telephone":

- 1) Suer shows a wireless **device**.

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2) "Wireless devices include PDA's and cell phones and wireless phones."

However, several problems exist in these two statements.

Problem 1

The Office Action is relying on Inherency. As explained above, no "basis in fact" or "technical reasoning" has been shown as to why Suer's wireless device includes, or suggests, the claimed wireless telephone.

Problem 2

The Office Action argues that Suer shows a genus ("wireless device"), which therefore includes a species ("wireless telephone.") However, by law, this argument is invalid.

A showing of a genus in a reference does not preclude a patent on a species. MPEP § 2144.08 states that, if a genus is taught in the prior art, whether a species of that genus is obvious is resolved by a case-by-case determination.

The Office Action has presented no evidence in support of its position of obviousness. It has only asserted that the genus (the PDA) is shown by the reference. That is insufficient.

Further, as explained below, Suer does not actually show a generic wireless device. He shows a PDA which uses line-of-sight infra-red communication. A wireless telephone is not a species of

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what Suer shows. A wireless telephone does not use line-of-sight transmission, nor IR transmission.

Problem 3

The Office Action is enlarging the actual teaching of Suer beyond what Suer states.

Suer, column 4, line 30 et seq., states that an IR (infrared) receiver may be attached to the "terminal" (the ATM), to allow communication with a customer's PDA (Personal Digital Assistant). Suer calls this "wireless communication." (Column 4, line 32.)

However, that communication is **direct communication between the PDA and the ATM**. That communication does not suggest a cellular telephone, which utilizes **indirect** communication.

That is, a cellular telephone communicates with an antenna on a cell tower, or possibly with a satellite. The cell tower/satellite then connects with land-based telephone lines, which, under Applicant's invention, lead to the ATM. This is an **indirect** connection between the cell phone and the ATM.

Suer, in showing **DIRECT IR communication between a PDA and an ATM**, plainly does not suggest **INDIRECT** communication using a cell phone.

This discussion applies to "wireless telephones" as well.

Therefore, Suer does not show "wireless" communication, in the sense that cell phones belong in the class of "wireless" devices

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which Suer shows.

In addition, Suer, in using IR as the carrier, is limited to line-of-sight communication. Cellular telephones do not possess that limitation. Even cordless telephones do not possess that limitation: they can be carried from room-to-room, away from their base stations.

Therefore, again, Suer does not show the genus of "wireless" communications, of which cell phones are a species. Thus, the two-step argument given by the Office Action, and set forth at the beginning of this Point 3, is incorrect.

#### Problem 4

Suer clearly contemplates using off-the-shelf components (and a minor amount of programming). He states that "an IR adapter may be plugged into the [ATM's] **serial, parallel, . . . USB, or IrDA port . . .**" Those communicate with a built-in IR port on the PDA. (Column 4, lines 34 - 40.)

Thus, in essence, Suer uses the PDA as a wireless keyboard for the ATM.

However, such a connection is not possible using a cellular telephone. A cellular telephone has keys which issue special signals, such as DTMF (Dual-Tone, Multi-Frequency) signals. An ordinary "Touch Tone" telephone issues such signals.

A cell phone cannot be connected to Suer's ATM in the manner

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suggested by Suer. Or, as a minimum, the Office Action has not shown how a cell phone can be so connected.

Therefore, no expectation of success has been shown, as to how a wireless telephone can be used to issue signals to Suer's ATM. The equipment present in Suer's disclosure is insufficient, and no additional equipment has been cited by the PTO.

MPEP § 706.02(j) states:

Contents of a 35 U.S.C. 103 Rejection

. . .  
To establish a prima facie case of obviousness, three basic criteria must be met.

. . .  
Second, there must be a reasonable expectation of success.

. . .  
The . . . reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure.

Problem 5

This Point 3, at the outset, pointed to two statements made by the Office Action. The subsequent discussion provides support for a significant problem with the two statements, as will now be explained.

The statements assert that Suer shows "wireless devices." However, that is technically incorrect. Wireless devices **generally**

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have not been shown in Suer.

As explained above, Suer shows a wireless device which engages in **direct IR communication with an ATM**. Such a device is not a generic class of devices which include wireless telephones.

Therefore, the statement that (1) Suer shows a wireless device which (2) thereby suggests a class of wireless devices which includes wireless telephones is not correct.

-- Wireless telephones do not use IR, as does Suer's device.

-- Wireless telephones do not require line-of-sight communication, as does Suer's IR device.

-- Cellular telephones do not engage in direct communication, as does Suer's IR device.

Stated more simply, the logic of the Office Action's position is flawed. The Office Action is asserting that Suer shows a generic class of wireless devices, which thereby suggests a wireless telephone. But Suer does not show such a generic class.

He shows a PDA which uses IR, line-of-sight, communication directly with an ATM. A wireless telephone is not a species of such a class of PDA's.

Thus, Suer does not suggest a class (or genus) of devices, which includes a wireless telephone as a species.

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Wireless telephones operate in a completely different manner than does Suer's PDA.

Problem 6

The logic of the Office Action is incorrect.

POINT 1

The Office Action asserts that

- 1) Suer shows a wireless device,
- 2) Wireless devices include wireless telephones,  
so that
- 3) Suer shows a wireless telephone.

However, this type of reasoning is not allowed in the law of patents, in determining what a reference teaches. A reductio ad absurdum example will illustrate.

A certain patent may show an automobile, which is a "vehicle." A vehicle carries items.

In the medical arts, a liquid, or solvent, which carries a vaccine, is called a "vehicle." (A hypodermic syringe injects the vehicle, plus the vaccine, into a patient.)

Plainly, the automobile-patent does not suggest the contents of the syringe (the vaccine-vehicle combination).

Similarly, the Suer patent, in showing a specific type of

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wireless device, does not suggest the use of every other type of device which can be called "wireless."

One factor in support of this conclusion is that, as explained above, Suer does not explain how a wireless telephone can be used in place of his PDA. No expectation of success has been shown.

#### POINT 2

The Office Action, in essence, points to a feature of Suer's PDA: it lacks wires.

The mere presence of a feature in a reference does not imply that the reference suggests all other devices having such features.

Restated, the PTO is asserting that Suer teaches that any wireless device whatsoever can be used in place of his PDA. That assertion is incorrect.

#### Problem 7

The Office Action is actually relying on a substitution-of-equivalents. It is asserting that a wireless telephone is equivalent to the PDA shown in Suer.

MPEP § 2144.06 states:

In order to rely on equivalence as a rationale supporting an obviousness rejection, the **equivalency must be recognized in the prior art**, and cannot be based on . . . the mere fact that the components at issue are functional or mechanical equivalents.

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The recognized "equivalency" has not been shown in the prior art.

#### **Point 4**

Office Action is self-contradictory.

On the one hand, the Office Action, page 5, top, asserts that Suer shows a wireless phone, by virtue of showing a PDA.

On the other hand, the Office Action immediately thereafter asserts that it is obvious to add a wireless phone to Suer. This assertion presumes the **absence** of a wireless phone in Suer.

A self-contradictory rejection is not allowed.

#### **Point 5**

No teaching is given for combining the references, and no wireless phone shown in the prior art.

The Office Action, page 5, top, asserts that it is obvious to include a wireless telephone in Suer, "to attract" users having different types of portable devices.

However, no wireless telephone has been shown in the applied references. All claim elements must be shown in the prior art.

Further, the rationale given is a non-sequitur: the rationale does not lead to the conclusion that a wireless telephone should be added to Suer. That is, the motivation is to attract more

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customers. However, to be attracted, **they must know** about the PTO's added feature in Suer. That feature allows wireless telephones to issue commands to an ATM.

But advertising is required in order to impart this knowledge to the customers. The Office Action has not suggested any advertising.

Therefore, the **mere addition** of wireless-telephone-capability to Suer does not attract any new customers. The new customers must **know** of the added capability. But the Office Action has not shown how new customers learn of the added capability.

Thus, the addition of the capability does not achieve the stated goal, of attracting new customers. It might, if the new customers knew about the added capability, but the PTO has not shown such knowledge in the customers.

#### CLAIM 2

Claim 2 states that a certain "program" is "retro-fitted" to the ATM, to allow the wireless telephone to function. That has not been shown in Suer, nor even asserted to be present.

Applicant points out that "retro-fit" means that the program which is "retro-fitted" is not present prior to the retro-fit. No such absence of a "program," followed by a "retro-fit," has been shown in Suer.

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**CLAIM 3**

Claim 3 recites "retro-fitting" a "transceiver" to the ATM. That has not been shown in Suer.

**CLAIMS 8, 15, 17, 18, 20 - 23, and 26 - 29**

The discussion of claim 1 applies to the claims identified in the heading above.

**Point 1**

In addition, claims 17, 18, 20, 22, 23, and 26 - 28 state that after a modification of an ATM, the ATM acquires a property which it did not possess before. That has not been shown in Suer.

**Point 2**

Claim 29 states that communication between the ATM and the telephone occur through "the network." That is contrary to Suer, wherein the communication between the ATM and PDA occur directly, by an IR link, and not through a network.

No expectation of success has been shown, as to how Suer can communicate using the "network," as claimed.

**Point 3**

Claim 21 recites "upgrading" a "program" on a "host," an "ATM," or both. That has not been shown in Suer.

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#### **CLAIMS 4 AND 5**

Claim 4 is considered patentable, based on its parent.

#### **CLAIM 6**

Claim 6, in simple terms, states that the modification allows the wireless telephone to connect to a network, to which the ATM is connected.

That has not been shown in Suer.

#### **CLAIM 7**

Claim 7 recites retro-fitting a "transceiver" to the ATM, which allows the wireless telephone to connect to a network, to which the ATM is connected.

That has not been shown in Suer.

#### **CLAIM 19**

The discussion of claim 1 applies to claim 19.

#### **RESPONSE TO CLAIM OBJECTIONS**

##### **Part 1**

In response to the 112 - rejections of claims 16 - 19, 24, 30, and 31, Applicant points out that, of these claims, only claims 17 - 19 remain pending.

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Claim 17 recites a "self service terminal" and then recites a characteristic of that terminal. That is clearly an apparatus claim.

It could be argued that the claim recites a terminal, and then a procedure which the terminal has experienced. The same conclusion is reached: it is clearly an apparatus claim. Under this argument, the claim is no different than the following: "A terminal which has been painted red." Being "painted" is the procedure, but the language still describes a characteristic of the apparatus: the apparatus is red.

The preceding applies to claims 18 and 19.

## **Part 2**

In response to the rejection based on non-enablement, Applicant points out that claims 17 - 19 have been amended to include a "means" recitation.

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**CONCLUSION**

Applicant requests that the rejections to the claims be reconsidered and withdrawn.

Applicant expresses thanks to the Examiner for the careful consideration given to this case.

Respectfully submitted,

  
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